

REMARKS

Claims 1-21 remain pending in the instant application, with claims 1, 10, 15, and 19 in independent form. Claim 3 and 7 have been amended to specify that the composition of claim 1 “further” comprises the components recited in claims 3 and 7, respectively, which addresses an objection to the form of claim 3 and 7 by the Examiner. Claim 8 has been amended to correct an inadvertent misspelling of the term “organo-titanium”. Claim 14 has been amended for antecedent basis relative to the claimed non-ferrous salt and source of ferrous ions. Claim 15 has been amended in accordance with the Examiner’s suggestions for purposes of clarifying the scope of the claim. Claim 22 was previously cancelled. No new claims are presently added. Table 1 of the specification of the application has also been amended to remedy grammatical errors therein as noted by the Examiner. The Applicants respectfully submit that no new matter is added through the amendments to the specification and the claims.

In the instant Office Action, the Examiner has objected to certain informalities in claim 8 and in the specification. The Applicants respectfully submit that the amendments to claim 8 and the specification as described above adequately address the bases for the Examiner’s objections such that the Applicants respectfully request the Examiner to withdraw the objections.

Claims 7, 8, and 14-18 stand rejected under 35 USC §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicants regard as the invention. Claims 1-6, 9-11, and 13-19 stand rejected under 35 USC §103(a) as being unpatentable over Amadaiji et al. (USPN 6,451,437) alone. Claims 12, 20, and 21 have been indicated as allowable, but for dependence upon a rejected base claim. In

view of the amendments to claims 3, 7, 14, and 15, the Applicants respectfully submit that the rejections under 35 USC §112, second paragraph, are overcome and must be withdrawn. With regard to the rejections under 35 USC §103(a), the Applicants respectfully traverse these rejections on the bases that: 1) Amadaiji et al. fails to adequately teach a diorganopolysiloxane composition **including a source of ferrous ions and non-ferrous salts in the amounts claimed**, 2) Amadaiji et al. fails to adequately teach the general conditions of independent claim 1 such that there is no basis for the Examiner to conclude that it would be obvious to optimize ranges of components taught by Amadaiji et al., and 3) that Amadaiji et al. fails to recognize any interaction whatsoever between ferrous ions and pyrithiones disclosed therein, especially at the amounts claimed, such that Amadaiji et al. fails to inherently teach a method of inhibiting or reducing discoloration of a diorganopolysiloxane as claimed in independent claim 10.

Rejections of Claims 1-6, 9-11, and 13-19 Under 35 USC §103(a) Over Amadaiji et al.

In addition to the Applicants' previous arguments, the Applicants respectfully submit that the Examiner's further rejections are in error for the reasons that are set forth below. First, the Applicants respectfully provide the relevant standards as they apply to the Examiner's new rejections.

The Examiner has taken the position that Amadaiji et al. teaches the invention of claim 1 with sufficient specificity as to constitute anticipation. The Examiner has further taken the alternative position that claim 1 is obvious over Amadaiji et al. based upon the principle that it is obvious to optimize a known result-effective variable. Finally, the Examiner has relied upon principles of inherent anticipation to reject dependent claim 10.

Although the Examiner has refrained from issuing any anticipation rejections of the instant claims, the Examiner has expressed a belief that Amadaiji et al. teaches the source of ferrous ions of the instant claims with sufficient specificity to constitute anticipation. However, the Applicants note that such a position is off-base and is moot due to the failure of Amadaiji et al. to adequately teach the claimed range for the amounts of the non-ferrous salt as claimed. As such, the instant analysis is entirely bound by the standards of obviousness, and **anticipation standards play no role in the instant analysis**. The Applicants respectfully note that such considerations are especially important with regard to the Examiner's finding that elements of claim 10 are inherent within the teachings of Amadaiji et al. Importantly, inherent anticipation standards have very limited applicability to the question of whether or not a claim is obvious over the prior art. After all, **it is impossible** for a given property, feature, or methodology (in the case of claim 10) to be "necessarily present" in a reference if the reference does not provide for the conditions that would result in the given property, feature, or methodology **always** being present within the prior art disclosure, which is required to satisfy the standards for inherency.

Notwithstanding the above, it is important to note that claim 10 would not be inherently anticipated even if Amadaiji et al. did teach a source of ferrous ions with sufficient specificity, and if the claimed range of the non-ferrous salt were taught in Amadaiji et al. In particular, the possibility that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. See MPEP 2112(IV.) citing *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993), and that "[t]o establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in

the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, **may not be established by probabilities or possibilities**. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’ ” See MPEP 2112(IV.) citing *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). “In relying upon the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. ” See MPEP 2112(IV.) citing *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).

To further illustrate proper application of the standards for establishing inherent anticipation of a claim, the Applicants refer to the recent case of *In re Whalen*, Appeal 2007-4423, which is a *binding* decision issued by the Board of Patent Appeals and Interferences. In *In re Whalen*, the issue was whether a prior art reference inherently anticipated a claim to a composition capable of embolizing an aneurysm and having components (a), (b), and (c), with the operative limitation being a requirement that component (a) has a molecular weight sufficient to impart to the composition a viscosity of at least about 150 cSt. Various prior art references disclosed a composition similar to the one claimed, but with no specific teachings as to the claimed viscosity of the composition. Notably, despite the fact that the prior art even taught similar compositions having the same components, with taught amounts of the components overlapping the amounts in the application at issue, the Board found that the claimed viscosity of the composition was **not** inherently anticipated by the teachings of the prior art. Importantly, the Board indicated that **“even if some of the compositions**

encompassed by [the prior art's] broad disclosure might have a viscosity of 150 cSt at 40°C, that possibility is not adequate to support a finding of inherent anticipation.” (Emphasis added). Clearly, the focus for purposes of establishing inherency rejections is **whether a functional limitation is an inherent characteristic of the prior art as a whole**, and the Board's reasoning makes clear that the possibility that some compositions in a reference may have a certain characteristic is insufficient to establish that the subject characteristic is inherent within the prior art reference as a whole.

As to the Examiner's reliance upon principles of obvious optimization of known result-effective variables, the Applicants recognize that optimization of ranges can provide a basis for establishing *prima facie* obviousness under some circumstances. Referring to MPEP 2144.05, “[g]enerally, differences in concentration or temperature will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration or temperature is critical”. Indeed, **“where the general conditions of a claim are disclosed in the prior art**, it is not inventive to discover the optimum or workable ranges by routine experimentation.” (Emphasis added, see MPEP 2144.05(II).(A.). However, referring to MPEP 2144.05(B.), “[a] particular parameter must first be recognized as a result-effective variable, i.e., **a variable which achieves a recognized result**, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation.” (Emphasis added, citing *In re Antonie*, 559 F.2d 618). As such, a key focus of the “routine optimization” analysis is whether there is a recognition in the art that the variable to be optimized achieves a recognized result, and it cannot be determined that optimization would be routine until a recognized result to be achieved is identified.

The Applicants recognize that the particular result that provides a basis for optimizing a variable, for purposes of the “routine optimization” analysis during examination, need not be the same result that is the focus of the invention at issue. However, as made clear through the foregoing references to the MPEP, **it is imperative that the optimization analysis be tied to a particular result achieved by the variable at issue, and a proper analysis must explain why it would be routine to optimize the variable to arrive within the confines of the claimed range at issue.** After all, if the prior art teaches or suggests a beneficial result that is attributable to higher amounts of a given component, it clearly cannot be concluded that one of skill in the art would include lower amounts of the component outside of the disclosed range in the prior art to “optimize” the amount of the component.

As applied to the instant circumstances, the Applicants respectfully submit that the standards for weighing obviousness of the invention claimed in at least independent claims 1, 10, 15, and 19 have not been met by the Examiner. As set forth above, the Applicants respectfully submit that the Examiner’s statements relative to the source of ferrous ions within Amadaiji et al. as being taught with sufficient specificity are misplaced, and the ultimate question is whether it would be obvious to select a source of ferrous ions from the list of “pigments” provided by Amadaiji et al., **while utilizing the non-ferrous salt in the instantly claimed amounts.** The Applicants note that the pigment and the non-ferrous salts of Amadaiji et al. are both **optional** ingredients. In fact, there is relatively little disclosure pertaining to the pigments and the non-ferrous salts in Amadaiji et al., **and the Examples of Amadaiji et al. don’t even include pigments or non-ferrous salts.** While the Applicants recognize that the Examiner can utilize the entire disclosure of Amadaiji et al. for all that it fairly teaches when

establishing rejections, such features of the disclosure of Amadaiji et al. even clearly suggest that the pigments and non-ferrous salts of Amadaiji et al. are insignificant. As such, the Applicants respectfully submit that the significance of the pigments and non-ferrous salts relative to the composition of Amadaiji et al. is no different than for any other coating composition in the art.

In addition to the above, Amadaiji et al. does **not** recognize that **lower amounts** of the non-ferrous salt present a result-effective variable. In fact, Amadaiji et al. teaches that very high amounts of the non-ferrous salt can be present with the purpose being to prevent fouling. There is no indication that adverse effects on the organopolysiloxane composition may be experienced with higher amounts of the non-ferrous salt and there is also no indication that amounts of the non-ferrous salt would effectively present fouling below an amount 0.1% by weight of the composition. As such, the Examiner has no basis for finding that minimizing costs and optimizing anti-fouling provide the motivation to modify the ranges for the non-ferrous salt as taught by Amadaiji et al. into the claimed range. Amadaiji et al, further fails to recognize that any property of the composition of Amadaiji et al. can be enhanced based upon the combination of the non-ferrous salts **or any other component disclosed therein**. In view of the foregoing, the Applicants respectfully submit that the Examiner has failed to adequately identify **a particular result to be achieved** by modifying the amount of the non-ferrous salts that are taught by Amadaiji et al., and has failed to adequately explain why it would be routine to “optimize” the amount of the non-ferrous salt within the confines of the claimed range at issue from the perspective of one of skill in the art. After all, one of skill in the art with knowledge of Amadaiji et al. would have no basis for belief that any amount of the non-ferrous

salts of less than 0.1% by weight would work for any purpose based upon the disclosures of Amadaiji et al., and the Examiner has failed to explain why it would be obvious to one of skill in the art to practice within the claimed range for the non-ferrous salt.

As to the Examiner's position that the method of inhibiting or reducing discoloration of a diorganopolysiloxane composition is an inherent property within the teachings of Amadaiji et al., for purposes of establishing the rejection of claim 10, the Applicants respectfully submit that the Examiner has failed to properly apply the standards for establishing inherency. As set forth above, inherency is not available as a tool for use in establishing an obviousness rejection. Indeed, the relevant standards for establishing inherency dictate that a given **functional limitation be an inherent characteristic of the prior art as a whole**. Clearly, Amadaiji et al. fails to recognize that any combination of the pigments and non-ferrous salts therein can be exploited to inhibit or reduce discoloration, or to achieve any particular result based on the combination. In other words, Amadaiji et al. fails to recognize any connection between the pigment and the non-ferrous salt. As such, it is fatal to the Examiner's position that Amadaiji et al. discloses pigments other than sources of ferrous ions because it cannot be established that **any** combination of the pigments and the non-ferrous salts would result in inhibition or reduction of discoloration as claimed. To satisfy the requirements of the inherency standards, **all** combinations of non-ferrous salts and pigments in the disclosure of Amadaiji et al. would have to satisfy the feature at issue, which clearly cannot be established by the Examiner.

In view of the foregoing, the Applicants respectfully submit that the Examiner's obviousness rejections of independent claims 1, 10, 15, and 19 over Amadaiji et al. have been overcome such that these rejections must be withdrawn. Thus, the Applicants respectfully

submit that independent claims 1, 10, 15, and 19, as well as the claims that depend therefrom, are in condition for allowance, which allowance is respectfully requested.

Because the due date for response without payment for an extension of time was Saturday, November 14, 2009 the Applicants respectfully submit that this Amendment is timely submitted on Monday, November 16 such that it is believed that no fees are presently due. However, the Commissioner is authorized to charge our deposit account no. 08-2789 for any additional fees or credit the account for any overpayment.

Respectfully submitted,

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